

REMARKS

The Office Action mailed April 17, 2009, has been received and reviewed. Claims 1-17 and 29-36 are currently pending in the application. Claims 34-36 are allowed. Claims 7, 10 and 11 are objected to as depending from a rejected base claim. Claims 1-6, 8, 9, 12-17 and 29-33 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein. No new matter has been added.

35 U.S.C. § 103 Obviousness Rejections

Obviousness Rejection Based on U.S. Pat. No. 6,901,062, U.S. Pat. No. 6,870,824 and U.S. Pub. No. 2003/0114162.

Claims 1-4, 6, 8, 9, 12, 17 and 29-32 were rejected as being unpatentable over U.S. Patent No. 6,901,062 to Scherzer et al (“Scherzer”) in view of U.S. Patent No. 6,870,824 to Kim et al (“Kim”) and further in view of U.S. Publication No. 2003/0114162 to Chheda *et al.* (“Chheda”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6, 8, 9, 12, 17 and 29-32 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

The Office Action concedes:

Scherzer et al. and Kim et al. do not disclose determining whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate. (Office Action, p. 3; emphasis added).

Applicant respectfully asserts that Applicant's independent claims 1, 6, 17 and 29, each recite in part, "*determining] whether to spread* at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*". Accordingly, Applicant's invention claims (1) "*orthogonal codes assigned ... as a function of the data rate*" and then (2) "*determining]* *whether to spread* at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*."

The Office Action then alleges:

Chheda et al. ... teach determining whether to spread at least a portion of *communications* to said one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate* ("... determination as to whether the Walsh code assigned to the user ...", *the data rate of the call should also be used to influence whether or not the Walsh code assigned to the call ...*, paras. [0020], [0023], [0061]). (Office Action, pp. 3-4; emphasis added).

Applicant respectfully disagrees with the Office Action's characterization of the actual teaching of Chheda and with the Office Action's assertion that Applicant's claims do not recite an order. In the Response to Arguments, the Office Action alleges Applicant's previous arguments regarding an "order" to the claim elements was unsupported since an ordering was not explicitly recited. Applicant respectfully asserts that an "ordering" of claim elements is, in fact, explicitly recited. Specifically, Applicant's claimed "determin[ing]" step recites an ordering by

clear recitation of verb tenses. Specifically, Applicant's "determin[ing]" step recites, *inter alia*, (1) "*orthogonal codes assigned ... as a function of the data rate*" and then (2) "*determin[ing] whether to spread* at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*." Clearly, a "determin[ing]" step, for example, that uses "codes assigned" would necessarily support an ordering of steps wherein an "assigning" step would have necessarily preceded the "determining" step that relies upon "codes assigned." Therefore, ordering is clearly explicitly present in Applicant's claimed invention.

Furthermore, the Office Action's citation to Chheda is mischaracterized, incomplete and misleading. Specifically, the Office Action cites Chheda stating, "*Chheda et al. teach ... the data rate of the call should also be used to influence whether or not the Walsh code assigned to the call ...*" (Office Action, pp. 3-4; emphasis added). The citation is an incomplete sentence. Specifically, the incomplete sentence states that the data rate should be used to influence whether or not the assigned code should be used to *do something*, however, the Office Action fails to cite the remainder of the teachings in Chheda which clearly teaches that Chheda's "data rate" was never part of a basis for assignment of codes as the Office Action attempts to infer. Specifically, Chheda unequivocally teaches:

The *data rate* of the call should also be *used to influence whether or not the Walsh code assigned to the call can be reused or not*. (Chheda, [0061], lns. 1-3; emphasis added).

Clearly, Chheda's teaching of the "data rate" being used to determine *code reuse cannot* teach the Office Action's admittedly untaught claim element of "*determin[ing] whether to spread* at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*." Accordingly, Applicant's "determin[ing]" element as conceded by the Examiner as not being taught in Scherzer and Kim, of (1) "*orthogonal codes assigned ... as a function of the data rate*" and then (2) "*determin[ing] whether to spread ... communications ... with one of the orthogonal codes assigned*", cannot be taught by Chheda's disclosure of "[t]he *data rate* of the call should also be *used to influence whether or not the Walsh code assigned to the call can be reused or*

not." (Chheda, [0061], lns. 1-3; emphasis added).

Therefore, since neither Scherzer nor Kim nor Chheda teach Applicant's claimed invention including "*determin[ing] whether to spread* at least a portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes assigned* to said one of the groups *as a function of the data rate*", these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 1, 6, 17 and 29. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 6, 17 and 29 be withdrawn.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 2-4 and 8, 9, 12 and 30-32 which variously depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 2-4 and 8, 9, 12 and 30-32 which variously depend therefrom.

Obviousness Rejection Based on Scherzer, Kim, Chheda and U.S. Pat. No. 6,424,631.

Claims 5, 13-16 and 33 were rejected as being unpatentable over Scherzer in view of Kim and Chheda and further in view of U.S. Patent No. 6,424,631 to Czaja *et al.* ("Czaja").
Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 5, 13-16 and 33 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 5, 13-16 and 33 which respectively depend therefrom.

Allowed Claims 34-36/Objections to Claims 7, 10 and 11

Claims 34-36 are allowed.

Claims 7, 10 and 11 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

Finality of Next Office Action Precluded

Applicant has traversed the rejection of claims 1-6, 8, 9, 12-17 and 29-33 by argument and not amendment. Therefore, the finality of the next office action would be improper as Applicant is entitled to an examination on the merits and to amend as a matter of right. In the present Office Action, Applicant's independent claims 1, 6, 17 and 29 were not completely examined as to all of the elements. Accordingly, Applicant submits that this omission to examine all elements of Applicant's claimed invention amounts to a failure to articulate a *prima facie* case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant. Consequently, a next office action cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such an office action sets forth a *prima facie* case. (MPEP § 706.07(a)).

CONCLUSION

Claims 1-17 and 29-36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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